IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: **Steven Shepley**	)	
Application No.: **10/722,067**	)	Art Unit 2876
Confirmation No.: **4154**	)	
Filed: **November 25, 2003**	)	Patent Examiner Thien Le
Title: **Cash Dispensing Automated Banking Machine Diagnostic Method**	)	

Mail Stop Appeal Brief - Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

BRIEF OF APPELLANT PURSUANT TO 37 C.F.R. § 41.37

Sir:

The Appellant hereby submits an Appeal Brief pursuant to 37 C.F.R. § 41.37 concerning the above-referenced Application. This Appeal Brief is in response to the Office Action dated September 9, 2005, which was made final.

(i) REAL PARTY IN INTEREST

The Assignee of all right, title and interest to the above-referenced Application is Diebold, Incorporated, an Ohio corporation.

(ii) RELATED APPEALS AND INTERFERENCES

Appellant, Appellant's legal representative, and assignee believe that there are no related appeals or interferences pertaining to this matter.

(iii) STATUS OF CLAIMS

Claims 1-6, 8-10, and 12-22 are pending in the Application.

Claims rejected: 1-22 [sic]

Claims allowed: none

Claims confirmed: none

Claims withdrawn: none

Claims objected to: none

Claims canceled: 7 and 11

Appellant appeals the rejections of claims 1-6, 8-10, and 12-22, inclusive. These rejections were in the Office Action ("Action") dated September 9, 2005.

(iv) STATUS OF AMENDMENTS

A final rejection was made September 9, 2005. No claim amendments were requested to be admitted after the final rejection.

(v) SUMMARY OF CLAIMED SUBJECT MATTER

Concise explanations of exemplary forms of the claimed invention:

For reasons of brevity, claim language may be referred to herein (and in Appellant's arguments) in a shortened version. For example, language such as "at least one" may be simply referred to as "a". Any generalized statement herein is not to limit any of the mentioned claims in any manner. Please refer to the specific claim for the exact claim language.

With respect to independent claim 1

An exemplary form of the invention is directed to a method. The method includes operatively connecting a portable diagnostic article (e.g., CD 98; Specification page 44, lines 2-4; page 60, lines 16-21; Figure 4) to an article reading device (e.g., CD reader 96; page 43, line 22; page 60, lines 16-21; Figure 4) of an automated banking machine (e.g., ATM 10)(e.g., page 43, line 13-page 44, line 4; Figure 4).

The method further includes outputting through an output device (e.g., display 36, 1544) diagnostic indicia (e.g., page 63, lines 5-9; page 86, lines 21-22; Figures 30-31). The diagnostic indicia corresponds to diagnostic data (e.g., page 59, line 16 to page 60, line 12) stored (e.g., in data store 78) in the machine (e.g., ATM 10) responsive to a condition of at least one transaction function device (94) (e.g., card reader 26, keypad 32, receipt printer 44, currency dispenser device 54) of the machine. The diagnostic indicia is prevented from being output except when the diagnostic article (98) has been operatively connected (e.g., page 67, lines 2 and 10) to the machine (e.g., ATM 10) (e.g., page 62, lines 6-8; page 64, lines 1-4; page 65, line 4-page 67, line 13; Figures 12-13).

The method also includes outputting through an output device (e.g., display 36, 1544) significance indicia which corresponds to service data (e.g., service information providing an indication of the significance of the diagnostic data; interpretation instructions; page 61, lines 3-6) stored on the portable diagnostic article (98), the output being provided after the diagnostic article (98) has been placed in operative connection with the machine (e.g., ATM 10). Note page 61, lines 3-11; page 62, line 6-page 63, line 2; page 86, lines 21-22; and Figures 12 and 31-32. Further description related to the exemplary form of the invention may be found, for example, at pages 59-87, and Figures 4, 13, and 19-30.

With respect to independent claim 18

Another exemplary form of the invention is directed to a method. Support in the disclosure for like reference numerals has previously been provided. The exemplary method includes operatively engaging a portable diagnostic article (e.g., 98) with at least one component (e.g., 96) of an automated banking machine (e.g., ATM 10).

The method further includes, responsive to the engaging of the portable diagnostic article (e.g., 98), operating the machine to enable an authorized machine servicer to obtain access to diagnostic data stored in machine memory (e.g., page 60, lines 10-18).

The method also includes, responsive to the engaging of the portable diagnostic article (e.g., 98) with the at least one machine component, operating the machine to enable the authorized machine servicer to access from the diagnostic article, machine servicing information applicable to the diagnostic data (e.g., servicing information providing an indication of the significance of the diagnostic data; interpretation instructions; page 61, lines 3-11; page 69, lines

11-22). Further description related to the exemplary form of the invention may be found, for example, at pages 59-87, and Figures 4, 12-13, and 19-32.

With respect to independent claim 20

A further exemplary form of the invention is directed to a method. Support in the disclosure for like reference numerals has previously been provided. The exemplary method includes operating an automated banking machine (e.g., ATM 10) to communicate with a diagnostic tool (e.g., 98) including significance data (e.g., page 61, lines 3-11). The machine is associated with memory having stored (e.g., 78) therein diagnostic data corresponding to at least one device (e.g., 94) of the machine.

The method further includes, responsive to operating the machine to communicate with the diagnostic tool (e.g., 98), operating the machine to output information corresponding to the stored diagnostic data (e.g., page 61, line 21 to page 62, line 8).

The method also includes operating the machine to output the significance data, wherein the significance data enables significance of the output (diagnostic) information to be provided (e.g., diagnostic data interpretation instructions; page 61, line 3 to page 62, line 8; page 68, lines 8-17; Figure 13). Further description related to the exemplary form of the invention may be found, for example, at pages 59-87, and Figures 4, 12, and 19-32.

(vi) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The questions presented in this appeal are:

1). Whether claim 1 is unpatentable pursuant to 35 U.S.C. § 102(b) as being anticipated by Gardner (US 5,861,614).

2). Whether claims 2-6, 8-10, and 12-17 are unpatentable pursuant to 35 U.S.C. § 103(a) as obvious over Gardner in view of Werth, et al. (US 4,369,442) (hereinafter "Werth").

3). Whether claims 18-22 are unpatentable pursuant to 35 U.S.C. § 103(a) as obvious over Gardner in view of Werth and Schwenke, et al. (US 6,556,950) (hereinafter "Schwenke").

(vii) ARGUMENT

The 35 U.S.C. § 102(e) Rejections

The Applicable Legal Standards

Anticipation pursuant to 35 U.S.C. § 102 requires that a single prior art reference contain all the elements of the claimed invention arranged in the manner recited in the claim. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983).

Anticipation under 35 U.S.C. § 102 requires in a single prior art disclosure, each and every element of the claimed invention arranged in a manner such that the reference would literally infringe the claims at issue if made later in time. *Lewmar Marine, Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 USPQ2d 1766, 1768 (Fed. Cir. 1987).

Anticipation by inherency requires that the Patent Office establish that persons skilled in the art would recognize that the missing element is necessarily present in the reference. To establish inherency the Office must prove through citation to prior art that the feature alleged to be inherent is "necessarily present" in a cited reference. Inherency may not be established based on probabilities or possibilities. It is plainly improper to reject a claim on the basis of 35 U.S.C. § 102 based merely on the possibility that a particular prior art disclosure could or might be used or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949 (Fed. Cir. 1999).

It is respectfully submitted that the Action from which this appeal is taken does not meet these burdens.

Gardner does not anticipate claim 1

Claim 1 was rejected under 35 U.S.C. § 102(b) as being anticipated by Gardner.

The Office alleges that Gardner teaches an ATM (10) and a portable diagnostic article (card 99). The Action is silent as what constitutes an output device, diagnostic indicia, diagnostic data, significance indicia, and service data in Gardner. The Appellant respectfully declines to speculate on behalf of the Office. The Office has not established a *prima facie* case of anticipation.

Claim 1

Gardner does not anticipate claim 1. For example, Gardner does not teach recited steps (b) or (c). Gardner does not output (1) indicia that corresponds to diagnostic data stored in an automated banking machine (step b) and (2) indicia that corresponds to service data stored on a portable diagnostic article (step c).

Step (b) includes "outputting through an output device, diagnostic indicia corresponding to diagnostic data stored in the machine responsive to a condition of at least one transaction function device of the machine". Gardner does not output indicia that corresponds to diagnostic data stored in an automated banking machine. Where does Gardner discuss storing diagnostic data in a machine responsive to a condition of a transaction function device? Where does Gardner teach "diagnostic data *stored in*" an automated banking machine? Gardner's card (99) does not have diagnostic data added thereto. Such action (if possible) would change the card data, would teach away from the disclosed purpose of the card having fixed data (col. 6, lines 5-13; col. 7, lines 9-20), and would render the card inoperative for its intended use.

Further, where does Gardner teach diagnostic data that was machine stored responsive to a *condition* of a transaction function device? Where does Gardner relate storing diagnostic data to a transaction function device condition? Additionally, where does Gardner output diagnostic indicia (that corresponds to diagnostic data that was machine stored responsive to a transaction function device condition) through an output device?

Gardner also does not teach that diagnostic indicia is "prevented from being output except when the diagnostic article has been operatively connected to the machine" (step b). Where does Gardner teach that diagnostic indicia is *prevented* from being output *except* when the card (99) is in the machine?

With regard to step (b), Gardner does not teach outputting diagnostic indicia through an output device, where (1) the diagnostic indicia corresponds to diagnostic data that was stored in the machine responsive to a machine transaction function device condition, and (2) having the diagnostic article operatively connected to the machine is required to allow the output. Gardner does not anticipate step (b).

Gardner also does not teach step (c). Gardner does not output indicia that corresponds to *service data stored on* a portable diagnostic article. No evidence has been presented that Gardner's *diagnostic* card (99) (i.e., the alleged portable diagnostic article) has *service data* stored thereon. Conversely, the card (99) appears to be used merely for availability of a "standard magnetic stripe card" (col. 6, line 7). Even the Action (on page 9, lines 9-11) acknowledges the limited usage of the card's "data to perform *diagnostic* tests". Gardner's card (99) does not have both diagnostic data and service data, as apparently alleged.

In Gardner a servicer receives a message about the tested reader (60) from the microcomputer (32), not from the card (99). There is no message on the card (99). Service data is never (before, during, or after testing) stored on the card (99). Indicia corresponding to article-stored service data is not output through an output device.

Even if it were somehow possible (which it isn't) for Gardner to teach the card (99) having service data, Gardner would still lack a teaching of *outputting indicia* that corresponds to that service data. Where does Gardner output indicia that corresponds to service data on the card (99) through an output device? Gardner's diagnostic card (99) cannot constitute the recited diagnostic article. Gardner does not anticipate step (c).

Gardner does not teach recited steps (b) or (c). It follows that Gardner cannot anticipate the recited method. Thus, Appellant respectfully submits that the 35 U.S.C. § 102(b) rejection of claim 1 should be reversed.

The 35 U.S.C. § 103 (a) Rejections

The Applicable Legal Standards

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie* obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. If the Office does not produce a *prima facie* case, then the Appellant is under no obligation to submit evidence of nonobviousness. MPEP § 2142.

The teaching, suggestion, or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Even if all of the features recited in the claim are known in the prior art, it is still not proper to reject a claim on the basis of obviousness unless there is a specific teaching, suggestion, or motivation in the prior art to produce the claimed combination. *Panduit Corp. v. Denison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

Evidence of record must teach or suggest the recited features. An assertion of knowledge and common sense not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001). Any rejection must be based on evidence of record. *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

It is respectfully submitted that the Action requiring appeal does not meet these burdens.

The Claims Are Not Obvious Over
Gardner in view of Werth

Claims 2-6, 8-10, and 12-17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gardner in view of Werth.

The Appellant respectfully disagrees with the interpretation and application of the references, as discussed in more detail hereafter. The Action's assertions are not based on any evidence in the record and thus lack substantial evidence support for the rejection. *In re Zurko*, supra. Nor is the determination of patentability in the Action based on evidence of record. *In re Lee*, supra.

Additional Comment

Appellant notes that claims 5, 6, 12, and 13 each include at least one typographical error that is clearly apparent. In claims 5, 12, and 13, step "(e)" should be labeled as step "(d)". In claim 6, steps "(f)" and "(g)" should be respectively labeled as steps "(e)" and "(f)" in the sequence of steps.

Although no claim informalities objection is pending, Appellant nevertheless grants authority to the Office to correct these typographical errors by Examiner's Amendment. Appellant respectfully submits that the merits of the claims are not affected, especially in light of the authorized corrections.

Claim 2

The Action admits that Gardner does not teach or suggest diagnostic indicia corresponding to a condition of a currency dispenser device. Nor is Gardner concerned with

diagnostic data corresponding to a condition of a currency dispenser device. It follows that the attempt to modify Gardner is clearly an attempt at hindsight reconstruction of Appellant's claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

Werth cannot alleviate the admitted deficiencies of Gardner as he does not teach or suggest the recited features which are not found in Gardner. Werth is non analogous art. Werth is directed to vending machines. One skilled in the art would recognize that Werth's vending machine is non analogous to Gardner's ATM. Even the Office (at Action page 10, lines 4-7) appears to admit such. Werth does not teach or suggest the diagnostic tools necessary to perform a diagnostic test on Gardner's ATM cash dispenser.

Furthermore, where does Werth teach or suggest outputting diagnostic *indicia*, especially diagnostic indicia corresponding to a currency dispenser condition (step b)? Nor has the Office explained how Gardner's magnetic stripe card (99), which is limited to testing a magnetic stripe card reader (60), can be used to perform a diagnostic test on a cash dispenser, as alleged. What does the magnetic stripe of card (99) have to do with testing a cash dispenser?

Additionally, Werth cannot alleviate the admitted deficiencies of Gardner with respect to step (c) as he likewise does not teach or suggest outputting indicia that corresponds to service data stored on a portable diagnostic article.

The Action is silent as to how the reference teachings could be combined to produce the recited invention. The two systems are structurally dissimilar and conflict. For example, Gardner requires a diagnostic card (99) inside a single ATM, whereas Werth requires that the PCU (29) remain external of plural vending machines (col. 1, lines 60-61; col. 4, lines 55-57).

The references, taken alone or in combination, do not teach or suggest the recited features, relationships, and steps. The Office has not established a *prima facie* showing of obviousness.

Claim 3

Claim 3 depends from claim 2/1. The references further do not teach or suggest outputting both diagnostic indicia corresponding to a currency dispenser condition (in step b) *and* significance indicia (in step c) through an output device on an automated banking machine. The Action is silent as to where Garner outputs the recited indicia through an output device of the ATM. Nor does Garner output the recited indicia through an ATM output device. The Action's remarks (on page 6, last paragraph) about Gardner having a "method of providing the diagnostic card inside an ATM housing" and a "method of having the diagnostic card inserted by a technician" are not pertinent to the actual claim language.

Although the Action relies solely on Gardner, Werth cannot alleviate the deficiencies of Gardner. Werth's LCD (42) is part of the PCU (29), not a vending machine (9). The Office has not established a *prima facie* case of obviousness.

Claim 4

Claim 4 depends from claim 3/2/1. The references further do not teach or suggest servicing an automated banking machine responsive to an outputting of significance indicia through an output device on the machine. For reasons previously discussed, the Office has not established a *prima facie* case of obviousness.

Claim 5

Claim 5 depends from claim 3/2/1. The references further do not teach or suggest providing an input to an input device of the automated banking machine to cause a diagnostic test of a transaction device of the machine. The Action (on page 7) alleges that "Gardner discloses that upon input from a technician . . . at the ATM's location, diagnostic tests are performed on the ATM". The Appellant respectfully disagrees.

Where in Gardner does a technician perform the diagnostic test while at the ATM location? Conversely, Gardner explicitly teaches that one of the advantageous features of his invention is to have the technician be remotely located from the ATM (col. 7, lines 60-64). The Office has not established a *prima facie* case of obviousness.

Where is an ATM "input device" for use in diagnostic testing in Gardner? There is no teaching or suggestion that Gardner uses an ATM's input device in conducting a diagnostic test. In Gardner the technician provides input to an input device of a terminal (28) that is remotely located from the ATM (10) (col. 6, lines 33-35; col. 7, lines 49-50 and 57). Likewise, Werth teaches using a portable unit (PCU with keyboard 29) exterior of the vending machine (col. 1, lines 60-61; col. 4, lines 55-57). Both Gardner and Werth teach against the Office's allegation. The Office has not established a *prima facie* case of obviousness.

Claim 6

Claim 6 depends from claim 5/3/2/1. The references further do not teach or suggest that in response to a diagnostic test result (and the service data), outputting indicia corresponding to the remedial action to take to service the machine.

The Action's remarks (on page 6, last paragraph) about Gardner having a "method of providing the diagnostic card inside an ATM housing" and a "method of having the diagnostic card inserted by a technician" are not pertinent to the actual claim language.

Although the Action relies solely on Gardner, Werth cannot alleviate the deficiencies of Gardner. The Office has not established a *prima facie* case of obviousness.

Claim 8

Claim 8 depends from claim 3/2/1. Appellant's remarks in support of the patentability of claim 5 are incorporated herein by reference. For reasons already discussed, the references do not teach or suggest providing input to a device of an automated banking machine. Gardner explicitly teaches that one of the advantageous features of his invention is to have the technician be remotely located from the ATM (col. 7, lines 60-64).

The references further do not teach or suggest the need of an authorized input, especially to carry out execution of steps (b) and (c). The Action (on page 7) admits that the references do not teach or suggest an authorized input. Thus, the Action does not factually support any *prima facie* conclusion of obviousness. The Action's assertion (on page 7) that "use of an authorization code for the diagnostic card" (of Gardner) is known, is not based on any evidence of record. *In re Zurko*, supra. *In re Lee*, supra. The Office has not established a *prima facie* case of obviousness.

Claim 9

Claim 9 depends from claim 3/2/1. The references further do not teach or suggest an automated banking machine including a browser. The Action is silent as to where the references teach or suggest the recited features. Neither Gardner nor Worth need a browser. Neither Gardner nor Worth even mention a browser. Even the Action (on page 7) admits that the

references do not teach or suggest a browser. Again, the Action does not factually support any *prima facie* conclusion of obviousness. *In re Zurko*, supra. *In re Lee*, supra.

Nor do the references teach or suggest providing input to an input device of the automated banking machine to process service data (that was stored on a portable diagnostic article; step c) through operation of an automated banking machine browser. Again, the Office has not established a *prima facie* case of obviousness.

Claim 10

Claim 10 depends from claim 9/3/2/1. The references further do not teach or suggest loading browser software from a portable diagnostic article to at least one controller operating in the automated banking machine. The Action is silent as to where the references teach or suggest the recited features.

The magnetic stripe on Gardner's diagnostic card (99) is read by the card reader (60) to test the card reader. There is no teaching or suggestion that the card (99) can support browser software. Nor is there any teaching or suggestion that browser software is read from the card (99). As previously discussed, neither Gardner nor Worth even mention use of a browser, browser software, or browser software on a portable diagnostic article. Even the Action (on page 7) admits that the references do not teach or suggest the recited features and relationships. The Office has not established a *prima facie* case of obviousness.

Claim 12

Claim 12 depends from claim 1. The references further do not teach or suggest the step of engaging a portable diagnostic article with a computer device other than an automated banking machine. The Action is silent as to where the references teach or suggest the recited features.

Where do the references teach or suggest a portable diagnostic article that can be (1) operatively connected to an article reading device of an automated banking machine, and (2) engaged with a computer device other than the automated banking machine?

Gardner's diagnostic card (99) is not engaged with a computer device other than an automated banking machine. As Gardner's diagnostic card (99) remains in the ATM, how can it engage a computer device not in operative connection with the ATM? Nor do the references teach or suggest that the computer device is operative to output indicia corresponding to the service data. The Office has not established a *prima facie* case of obviousness.

Claim 13

Claim 13 depends from claim 12/1. The references further do not teach or suggest service data (stored on a portable diagnostic article) corresponding to instructions for servicing an automated banking machine, nor outputting the instructions. The Action is silent as to where the references teach or suggest the recited features. The Office's relied upon diagnostic card (99) in Gardner does not have instructions for servicing an automated banking machine. The Office has not established a *prima facie* case of obviousness.

Claim 14

Claim 14 depends from claim 13/12/1. The references further do not teach or suggest that the portable diagnostic article comprises a CD. Nor do references teach or suggest that step (a) comprises placing the CD in a CD reader of the automated banking machine. The Action (on page 7) admits that the applied references do not teach or suggest a CD and a CD reader. Thus, the Action does not factually support any *prima facie* conclusion of obviousness. *In re Zurko*, supra. *In re Lee*, supra.

The Office's assertion that it would be obvious to modify Gardner "because the use of a CD/CD Reader in place of a memory card/card reader is merely a substitution of an art recognized functional equivalent" is without merit, unreasonable, and smacks of hindsight reconstruction. In Gardner, a card (not a CD) is required because the magnetic stripe on the card (99) is needed to test the card reader (60). There is no teaching or suggestion of record of a CD having a magnetic stripe that could be substituted for the card (99) in testing the card reader (60). Nor is there any teaching or suggestion of record of ATM customers using a CD (instead of a card) to access the ATM. Nor is there any teaching or suggestion of record of an ATM having a CD reader for reading CDs used by customers to access the ATM.

The attempt to modify Gardner is clearly an attempt at hindsight reconstruction of Appellant's claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, supra. The rejections, which lack the necessary evidence and rationale, are based on knowledge gleaned only from Appellant's disclosure. The Office has not established a *prima facie* case of obviousness.

Claim 15

Claim 15 depends from claim 1. The references further do not teach or suggest providing a secret code on the diagnostic article, nor linking step (b) or step (c) to the secret code being an authorized code as determined through operation of the machine. The Action (on page 7) admits that the applied references do not teach or suggest use of a secret code in the manner recited. There is no teaching or suggestion that Gardner's diagnostic card (99) has a secret code, or that step (b) or step (c) is performed responsive to the code being authorized as determined through operation of the machine. Nor does the card need a secret code that can be authorized. The

Office has not established a *prima facie* case of obviousness. *In re Zurko*, supra. *In re Lee*, supra.

The Action (at page 10, lines 8-12) indicates that the rejection was maintained "because applicant fails to provide any reason why the grounds of rejections on claim 15 . . . does not meet the limitations of this particular claim". Appellant respectfully submits that the reason provided is not a valid basis for maintaining the rejection. The Appellant is under no obligation to submit any evidence of nonobviousness or prove patentability. Conversely, the burden is on the Office to establish a *prima facie* case of obviousness under the law. MPEP § 2142. Otherwise (which is the current situation), the Office is legally required to issue a patent.

Claim 16

Claim 16 depends from claim 15/1. The references further do not teach or suggest that machine determination as to whether a secret code on a diagnostic article is an authorized code, is dependent on a current date determined by the machine. The Action (on page 7) admits that the references do not teach or suggest the recited features and relationships. As no other prior art teaching or suggestion has been applied, the Office has not established a *prima facie* case of obviousness. *In re Zurko*, supra. *In re Lee*, supra.

Claim 17

Claim 17 depends from claim 3/2/1. The references further do not teach or suggest that the portable diagnostic article has encrypted service data, and decrypting the service data through operation of the machine. There is no teaching or suggestion that Gardner's diagnostic card (99) has encrypted service data. Even the Action (on page 7) admits that the references do not teach or suggest a portable diagnostic article with encrypted service data. Nor does the card need

encrypted service data. The Office has not established a *prima facie* case of obviousness. *In re Zurko*, supra. *In re Lee*, supra.

The Claims Are Not Obvious Over
Gardner in view of Werth and Schwenke

Claims 18-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gardner in view of Werth and Schwenke.

The Office alleges (on Action page 7, last paragraph) that Gardner/Werth teach all of the claimed features except for diagnostic data being stored in machine memory. The Action refers to the previous discussions regarding claims 1-17. These previous rejections relied upon Gardner's diagnostic card (99) as being the recited portable diagnostic article.

The Office (on Action page 8) relies on Schwenke for allegedly disclosing "a diagnostic method and apparatus comprising a processor 512 having a built-in diagnostic engine 522". The Office further alleges that it would have been obvious (for Gardner) "to incorporate the diagnostic data from the card to into the controller of the ATM machine in the manner as suggested by Schwenke". The Office reasons that the proposed modification to Gardner "reduces the need of moving the diagnostic card 99 in the manner as taught by Gardner while still preserving the underlying inventiveness concepts of his system".

The Appellant respectfully disagrees with the interpretation and application of the references, as discussed in more detail hereafter. The Action's assertions are not based on any evidence in the record and thus lack substantial evidence support for the rejection. *In re Zurko*, supra. Nor is the determination of patentability based on evidence of record. *In re Lee*, supra.

Foremost, one skilled in the art would recognize that the basis for all the rejections is without merit. The proposed modification to Gardner is *prima facie* unreasonable. Gardner's magnetic stripe card reader (60) operates by reading magnetic data from a card (col. 6, lines 8-11; col. 7, lines 9-14). Gardner's magnetic stripe card (99) is required because the (known) magnetic stripe data on the card (99) is needed to test whether the magnetic stripe card reader (60) is correctly reading. The Office has not explained how Gardner's magnetic stripe card reader (60) could be tested without using a tangible magnetic stripe card.

To allege that Gardner's physical card (99), which contains the magnetic stripe necessary to test the magnetic stripe card reader (60), can be replaced by data stored in "the controller of the ATM" is unreasonable and without legal basis. The proposed modification to Gardner would not structurally or functionally enable proper testing of the card reader (60). It would not have been obvious to one having ordinary skill in the art to have modified Gardner as proposed by the Office. Thus, the Office has not presented a *prima facie* case of obviousness.

Furthermore, not only is the proposed modification to Gardner unreasonable, but it would also be directly contrary to Gardner's explicit teaching and would destroy the disclosed and desired utility and operability of the Gardner teaching. That is, the alleged modification to Gardner would render the reference inoperable for its intended and desired purpose (i.e., testing a magnetic stripe card reader by using a magnetic stripe card). However, an obviousness rejection cannot be based on modification of a reference if making the modification results in destroying the disclosed utility or advantage of the device shown in the prior art reference. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1598-99 (Fed. Cir. 1988). Again, the Office has not established a *prima facie* case of obviousness.

It would not have been obvious to one having ordinary skill in the art to have modified Gardner as alleged. Even if it were somehow possible (which it isn't) for Gardner to have been modified as alleged, the modified Gardner still would not have resulted in the recited method. Based on these initial reasons alone the rejections should be reversed. Additional reasons regarding specific claims follow.

Claim 18

The Office alleges (on Action page 7, last paragraph) that Gardner/Werth teach all of the claimed features except for diagnostic data being stored in machine memory. That is, the Office admits that Gardner/Werth do not teach or suggest recited step (b).

As discussed above, the proposed modification to Gardner is unreasonable. It would not have been obvious to one having ordinary skill in the art to have replaced Gardner's physical card (99), which contains the magnetic stripe necessary to test the magnetic stripe card reader (60), by data stored in "the controller of the ATM". The Office has not established a *prima facie* case of obviousness.

Schwenke is non analogous art. Schwenke is directed to system software for managing the design, simulation, implementation, and maintenance of a manufacturing process. Schwenke is not relevant to testing a magnetic stripe card reader (like Gardner's card reader 60). Schwenke doesn't even mention a card reader. One having ordinary skill in the art would not have looked to Schwenke for testing the magnetic stripe card reader (60) in Gardner's ATM (10). Nor can Schwenke alleviate the deficiencies of Gardner/Werth. The Office has not established a *prima facie* case of obviousness.

Appellant also respectfully submits that Gardner/Werth do not teach or suggest recited step (c). The rejection relies on Gardner's diagnostic card (99) as being the recited portable diagnostic article. However, Gardner's diagnostic card (99) cannot constitute the recited diagnostic article. Gardner does not teach or suggest enabling a machine servicer to access machine servicing information, applicable to the diagnostic data, from the diagnostic card (99) (i.e., the alleged article). Where does a machine servicer in Gardner access machine servicing information from the diagnostic card (99)? The references do not teach or suggest recited step (c). Nor has the Office established a *prima facie* case of obviousness.

Even if it were somehow possible (which it isn't) for sake of argument to have replaced Gardner's physical card (99) by data stored in "the controller of the ATM", as proposed by the Office, the references still would not teach or suggest recited step (c). Step (c) includes enabling a machine servicer to access machine servicing information from the article, responsive to step (a). Step (a) includes engaging the article with an automated banking machine component. The Office has not explained how "data" (stored in an ATM controller, as proposed by the Office) could constitute a physical "article". Again, the Office has not established a *prima facie* case of obviousness. It would not have been obvious to one having ordinary skill in the art to have modified the references as alleged to have produced the recited invention.

Claim 19

Claim 19 depends from claim 18. Appellant's remarks in support of the patentability of claim 2 are incorporated herein by reference. The references, taken alone or in combination, further do not teach or suggest the recited method.

The Action (on page 6) admits that Gardner does not teach or suggest diagnostic data corresponding to a condition of a currency dispenser. Nor is Gardner concerned with diagnostic data corresponding to a currency dispenser condition. It follows that the attempt to modify Gardner is clearly an attempt at hindsight reconstruction of Appellant's claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, supra.

As best understood, the Office relies on Werth for the features of claim 19. However, Werth cannot alleviate the admitted deficiencies of Gardner as he does not teach or suggest the recited features which are not found in Gardner. As previously discussed (claim 2 remarks), Werth is non analogous art. It would not have been obvious to one having ordinary skill in the art of automated banking machines to have modified Gardner with Werth to have produced the recited method.

Nor has the Office explained how Gardner's magnetic stripe card (99), which is limited to testing a magnetic stripe card reader (60), can be used to perform a diagnostic test on a currency dispenser, as apparently alleged. What does the magnetic stripe of card (99) have to do with testing a cash dispenser?

Schwenke (like Werth) also cannot alleviate the admitted deficiencies of Gardner as he does not teach or suggest the recited features which are not found in Gardner. Where does Schwenke even mention a currency dispenser? The Office has not established a *prima facie* case of obviousness.

Claim 20

Appellant's remarks in support of the patentability of claim 18 are incorporated herein by reference. The references, taken alone or in combination, do not teach or suggest the recited method. The Office admits that Gardner/Werth do not teach or suggest diagnostic data stored in memory. For reasons already discussed, it would not have been obvious to one having ordinary skill in the art to have replaced Gardner's physical card (99) as alleged by the Office. For reasons already discussed, the Office has not established a *prima facie* case of obviousness.

Also, as best understood, the rejection relies on Gardner's diagnostic card (99) as being the recited diagnostic tool. However, step (a) recites that the diagnostic tool includes the significance data. Gardner's card (99) does not include the recited significance data. Thus, Gardner's diagnostic card (99) cannot constitute the recited diagnostic tool. It follows that the references do not teach or suggest recited step (a). Again, the Office has not established a *prima facie* case of obviousness.

Appellant respectfully submits that the references also do not teach or suggest the significance data recited in step (c). Step (a) recites that the diagnostic tool includes the significance data. Where do the references, taken alone or in combination, teach or suggest outputting (significance) data which enables the significance of outputted diagnostic data information to be provided?

Where do the references teach or suggest outputting both diagnostic data information (step b) and significance data (step c)? Further, where do the references teach or suggest operating an automated banking machine to output both diagnostic data information (corresponding to at least one machine device) and significance data (which enables the

significance of the outputted information to be provided)? The references do not teach or suggest recited steps. Nor has the Office established a *prima facie* case of obviousness. It would not have been obvious to one having ordinary skill in the art to have modified the references as alleged to have produced the recited invention.

Claim 21

Claim 21 depends from claim 20. The references, taken alone or in combination, further do not teach or suggest the recited method of claim 21. Appellant's remarks in support of the patentability of claim 3 are incorporated herein by reference. Schwenke also cannot alleviate the deficiencies of Gardner as he does not teach or suggest the recited features which are not found in Gardner.

Where do the references teach or suggest operating an automated banking machine to output both diagnostic data information (corresponding to at least one machine device) and significance data (which enables the significance of the outputted information to be provided) through the same at least one machine display? The Office has not established a *prima facie* case of obviousness.

Claim 22

Claim 22 depends from claim 20. The references, taken alone or in combination, further do not teach or suggest the recited method of claim 22.

Where do the references teach or suggest obtaining machine servicing instructions from a diagnostic tool, and operating an automated banking machine to output both diagnostic data information (corresponding to at least one machine device) and indicia corresponding to the obtained machine servicing instructions (and which indicia enables the significance of the

outputted information to be provided)? The Office has not established a *prima facie* case of obviousness.

CONCLUSION

Each of Appellant's pending claims specifically recites features, relationships, and steps that are neither disclosed nor suggested in any of the applied prior art. Furthermore, the applied prior art is devoid of any teaching, suggestion, or motivation for combining features of the applied prior art so as to produce the recited invention. For these reasons it is respectfully submitted that all the pending claims are allowable.

Respectfully submitted,

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(viii) **CLAIMS APPENDIX**

1. A method comprising:

(a) operatively connecting a portable diagnostic article to an article reading device of an automated banking machine;

(b) outputting through an output device, diagnostic indicia corresponding to diagnostic data stored in the machine responsive to a condition of at least one transaction function device of the machine, the diagnostic indicia being prevented from being output except when the diagnostic article has been operatively connected to the machine;

(c) outputting through an output device significance indicia corresponding to service data stored on the portable diagnostic article after the diagnostic article has been placed in operative connection with the machine.

2. The method according to claim 1 wherein the automated banking machine includes a currency dispenser device, and wherein in step (b) the diagnostic indicia includes indicia corresponding to a condition of the currency dispenser device.

3. The method according to claim 2 wherein in step (b) and in step (c) the indicia is output through at least one output device on the automated banking machine.

4. The method according to claim 3 and further comprising:

(d) servicing the automated banking machine responsive to the significance indicia.

5. The method according to claim 3 and further comprising:

(e) providing at least one input to at least one input device of the automated banking machine, wherein the automated banking machine is operative responsive to the at least one input and the operative connection of the diagnostic article with the machine to cause the automated banking machine to conduct at least one diagnostic test of at least one transaction device of the machine.

6. The method according to claim 5 wherein the at least one diagnostic test is operative to produce at least one result, and further comprising:

(f) outputting through an output device of the machine responsive to the at least one result and the service data, indicia corresponding to a remedial action;

(g) servicing the machine by taking the remedial action.

7. (canceled)

8. The method according to claim 3 and further comprising:

providing at least one input to at least one device of the automated banking machine, wherein steps (b) and (c) are executed only when the at least one input comprises an authorized input.

9. The method according to claim 3 wherein the automated banking machine includes a browser, and further comprising:

(d) providing at least one input to at least one input device of the automated banking machine to process the service data through operation of the browser.

10. The method according to claim 9 and prior to step (d) further comprising:

loading browser software from the portable diagnostic article to at least one controller operating in the automated banking machine.

11. (canceled)

12. The method according to claim 1 and further comprising:

(e) engaging the portable diagnostic article with a computer device other than an automated banking machine, wherein the computer device is not in operative connection with an automated banking machine, and wherein the computer device is operative to output indicia corresponding to the service data.

13. The method according to claim 12 wherein the service data corresponds to instructions for servicing the automated banking machine, and wherein in step (c) and in step (e) indicia corresponding to the instructions are output.

14. The method according to claim 13 wherein the portable diagnostic article comprises a CD and wherein step (a) comprises placing the CD in a CD reader of the automated banking machine.

15. The method according to claim 1 and prior to step (b) providing at least one secret code on the diagnostic article, wherein at least one of steps (b) and (c) are performed responsive to the at least one secret code being an authorized code as determined through operation of the machine.

16. The method according to claim 15 wherein the determination by the machine as to whether the secret code is authorized is dependent on a current date determined by the machine.

17. The method according to claim 3 and wherein the service data on the portable diagnostic article is encrypted, and prior to step (c) decrypting the service data through operation of the machine.

18. A method comprising:

(a) operatively engaging a portable diagnostic article with at least one component of an automated banking machine;

(b) responsive to step (a), operating the machine to enable an authorized machine servicer to obtain access to diagnostic data stored in machine memory;

(c) responsive to step (a), operating the machine to enable the authorized machine servicer to access from the article, machine servicing information applicable to the diagnostic data.

19. The method according to claim 18 wherein the automated banking machine includes a currency dispenser, wherein the diagnostic data corresponds to a condition of the currency dispenser, and wherein step (a) includes placing the article into the automated banking machine.

20. A method comprising:

(a) operating an automated banking machine to communicate with a diagnostic tool, wherein the machine is associated with memory having stored therein diagnostic data corresponding to at least one device of the machine, wherein the diagnostic tool includes significance data;

(b) responsive to step (a), operating the machine to output information corresponding to the diagnostic data;

(c) operating the machine to output the significance data, wherein the significance data enables significance of the information output in step (b) to be provided.

21. The method according to claim 20 wherein step (b) includes operating the machine to output information through at least one display of the machine, wherein step (c) includes operating the machine to output significance data through the at least one display.

22. The method according to claim 20 wherein the significance data corresponds to machine servicing instructions, wherein step (a) includes obtaining machine servicing instructions from the diagnostic tool, and wherein step (c) includes operating the machine to output indicia corresponding to obtained machine servicing instructions.

(ix) EVIDENCE APPENDIX

(None)

(x) **RELATED PROCEEDINGS APPENDIX**

(None)